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10/025,770	12/26/2001	Takashi Oshiba	089367-0118	5864

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FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/025,770	<b>Applicant(s)</b> OSHIBA ET AL.	
	<b>Examiner</b> JOHN VAN BRAMER	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8-12,19-23,30-34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-12,19-23,30-34 and 36-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2008 has been entered.

### ***Response to Amendment***

2. The amendment filed December 22, 2008 has cancelled no claims. Claims 1, 8, 9, 12, 19, 20, 23, 30, 31, 34, 36, and 38-40 were amended and new claims 41-44 were added. Thus the currently pending claims in the application are 1, 8-12, 19-23, 30-34, and 36-44.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 10-12, 21-23, 32-34, and 37-40 rejected under 35 U.S.C. 102(b) as being anticipated by Roth et al. (WO 98/34189).

Claims 1, 12 and 23: Roth discloses an advertisement opportunity trading system, method and a market control server that includes a plurality of sponsors, said system enabling communication between a terminal of one of the plurality of sponsors of an advertisement and a terminal of media which distributes an advertisement via a communication network that is communicatively connected to a plurality of terminals of the plurality of sponsors, respectively, in or to intermediate between one of the plurality of sponsors and the media for facilitating a trade for an advertisement opportunity offered by the media, said system and server comprising:

- a. An advertisement data reception unit which receives advertisement data from the one of the plurality of sponsors who wants the advertisement data to be distributed on an advertisement opportunity, the advertisement data including genre data describing a genre of the advertisement. (Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 19, line 27 through Page 20, line 26; and Fig. 5B, 517) (The Merriam-Webster dictionary defines “genre” as a “kind, or sort” in relation to a particular style, form or content. In the section cited, Roth discloses the ability of a site to define the type of advertising content that it is willing to accept, such as java, gif, or file size. Additionally, Roth discloses that ad selection may be based upon CT (Content type) which would also be considered genre data of the advertisement)
- b. An advertisement opportunity reception unit which receives an advertisement opportunity offered by media that includes prohibited genre data designating

- a genre of advertisement that will not be permitted for the advertisement opportunity. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)
- c. An advertisement data check unit that checks whether the genre data of the advertisement data corresponds to the prohibited genre data of the advertisement opportunity and notifies a result of said checking to the media. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)
  - d. A distribution accepting unit which accepts an application for distribution of the advertisement data from the one of the plurality of sponsors only after receiving information from the media representing that distribution of the advertisement data is appropriate for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15; Page 20 line 16; and Page 22, lines 1-9)
  - e. A trade process unit which performs a process for trading the advertisement opportunity based on the application accepted by said distribution accepting unit. (Page 6, line 17 through Page 7, line 15)
  - f. An advertisement data registration unit which registers the advertisement data received by said advertisement data reception unit. (Page 6, line 17 through Page 7, line 15)
  - g. An advertisement opportunity registration unit which registers the advertisement opportunity received by said advertisement opportunity reception unit. (Page 6, line 17 through Page 7, line 15)

- h. An advertisement opportunity publicizing unit which publicizes information on the advertisement opportunity registered in said advertisement opportunity registration unit via said communication network, wherein said distribution accepting unit accepts an application for distribution of the advertisement data registered in said advertisement data registration unit from the sponsor.  
(Page 6, line 17 through Page 7, line 15)
- i. Wherein in a case where said distribution accepting unit accepts applications for distribution of advertisement data from others of the plurality of sponsors for a same advertisement opportunity, said trade process unit puts up the advertisement opportunity for auction. (Page 6, line 17 through Page 7, line 15)
- j. A plurality of advertisement data can be registered by any of the plurality of sponsors in said advertisement data registration unit for one advertisement opportunity. (Page 23, line 8 through Page 24, line 1)
- k. In a case where the media determines that the plurality of advertisement data of the one of the plurality of sponsors are appropriate for distribution on the one advertisement opportunity, said distribution accepting unit accepts an application for distribution of one advertisement data designated by the one of the plurality of sponsors from the plurality of advertisement data, as one to be actually distributed. (Page 23, line 8 through Page 24, line 1)
- l. Wherein said advertisement data reception unit changes the advertisement data designated by the one of the plurality of sponsors as one to be actually

distributed with another advertisement data among the plurality of advertisement data in accordance with an instruction from the one of the plurality of sponsors. (Page 26, line 6 through Page 27, line 2)

Claims 10, 11, 21, 22, 32, and 33: Roth discloses the advertisement trading system, method and market control server according to claims 1, 12, and 23 respectively, further comprising an advertisement data mirroring unit which transmits advertisement data which is determined as appropriate for distribution by the media to an advertisement distribution controller which performs distribution of advertisement data, wherein:

- a. Said advertisement data mirroring unit transmits the advertisement data to said advertisement distribution controller before a trade for an advertisement opportunity is started by said trade process unit. (Page 23, line 8 through Page 24, line 1)
- b. Said advertisement distribution controller stores the transmitted advertisement data, and performs distribution of the stored advertisement data which is to be distributed on an advertisement opportunity, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 34: Roth discloses a computer-readable recording medium which stores a program for controlling a computer to function as:

- a. Advertisement data receiving means for receiving advertisement data from one of a plurality of sponsors who wants the advertisement data to be distributed on an advertisement opportunity, the advertisement data including genre data describing a genre of the advertisement. (Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 19, line 27 through Page 20, line 26; and Fig. 5B, 517) (The Merriam-Webster dictionary defines “genre” as a “kind, or sort” in relation to a particular style, form or content. In the section cited Roth discloses the ability of a site to define the type of advertising content that it is willing to accept, such as java, gif, or file size. Additionally, Roth discloses that ad selection may be based upon CT (Content type) which would also be considered genre data of the advertisement)
- b. Advertisement data registering means for registering the advertisement data received by said advertisement data receiving means. (Page 6, line 17 through Page 7, line 15)
- c. Advertisement opportunity receiving means for receiving an advertisement opportunity offered by media, the advertisement opportunity including prohibited genre data designating a genre of advertisement that will not be permitted for the advertisement opportunity. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)
- d. Advertisement opportunity registering means for registering the advertisement opportunity received by said advertisement opportunity receiving means. (Page 6, line 17 through Page 7, line 15)

- e. Advertisement opportunity publicizing means for publicizing information on the advertisement opportunity registered by said advertisement opportunity registering means via said communication network. (Page 6, line 17 through Page 7, line 15)
- f. Advertisement data check means that checks whether the genre data of the advertisement data corresponds to the prohibited genre data of the advertisement opportunity and notifies a result of said checking to the media. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)
- g. Distribution accepting means for accepting an application for distribution of the advertisement data from the one of the plurality of sponsors only after receiving information from the media representing that distribution of the advertisement data is appropriate for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15; Page 20, line 16, and Page 22, lines 1-9)
- h. A trade processing means for performing a process for trading the advertisement opportunity based on the application accepted by said distribution accepting means. (Page 6, line 17 through Page 7, line 15)
- i. Wherein determining that the advertisement is appropriate for the advertisement opportunity comprises:
  - a. Designating means for designating one advertisement data out of a plurality of advertisement data registered by the one of the plurality of sponsors for one advertisement opportunity as one to be actually distributed. (Page 23, line 8 through Page 24, line 1)

- b. Wherein the advertisement data designated by the one of the plurality of sponsors as one to be actually distributed is changed with another advertisement data among the plurality of advertisement data in accordance with an instruction from the one of the plurality of sponsors.  
(Page 26, line 6 through Page 27, line 2)

Claim 37: Roth discloses the computer-readable recording medium according to claim 34, storing a program for controlling a computer to further function as:

- a. Advertisement data mirroring means for transmitting advertisement data which is determined as appropriate for distribution by the media to advertisement distribution controlling means for performing distribution of advertisement data before a trade for an advertisement opportunity is started by said trade processing means. (Page 23, line 8 through Page 24, line 1)
- b. Advertisement distribution controlling means for storing the transmitted advertisement data and performing distribution of the stored advertisement data which is to be distributed on an advertisement opportunity, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claims 38, 39 and 40: Roth discloses an advertisement trading and distribution control apparatus, method and computer-readable medium which provides

information and an advertisement data to a terminal of an audience, said apparatus, method, and computer readable medium comprising:

- a. A trade process unit for performing a trading of an advertisement opportunity offered by a media in connection with advertisement data from one of a plurality of sponsors, said advertisement data to be distributed on the advertisement opportunity to the terminal of the audience, the advertisement data including genre data describing a genre of the advertisement. (Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 19, line 27 through Page 20, line 26; and Fig. 5B, 517) (The Merriam-Webster dictionary defines “genre” as a “kind, or sort” in relation to a particular style, form or content. In the section cited Roth discloses the ability of a site to define the type of advertising content that it is willing to accept, such as java, gif, or file size. Additionally, Roth discloses that ad selection may be based upon CT (Content type) which would also be considered genre data of the advertisement)
- b. Advertisement data check means that checks whether the genre data of the advertisement data corresponds to prohibited genre data of an advertisement opportunity and notifying to a media that offers the advertisement opportunity said result of checking. (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26)
- c. Distributing means for distributing the advertisement data to said terminal of an audience from a market control server which intermediated between the

- one of the plurality of sponsors of the advertisement data and the media only after receiving information from the media representing that distribution of the advertisement is appropriate for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15; Page 20, line 16; and Page 22, lines 1-9)
- d. Storing means for receiving advertisement data to be provided to the terminal of the audience from said market control server, and storing the received advertisement data, wherein said distributing means starts distributing the advertisement data stored in said storing means to said terminal of an audience from a time set for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15)
- e. Wherein determining that the advertisement is appropriate for the advertisement opportunity comprises:
- a. Designating means for designating one advertisement data out of a plurality of advertisement data registered by the one of the plurality of sponsors for one advertisement opportunity as one to be actually distributed. (Page 23, line 8 through Page 24, line 1)
- b. Wherein the advertisement data designated by the one of the plurality of sponsors as one to be actually distributed is changed with another advertisement data among the plurality of advertisement data in accordance with an instruction from the one of the plurality of sponsors. (Page 26, line 6 through Page 27, line 2)

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Claims 41, 42, 43, and 44: The advertisement opportunity trading system, the market control server, the advertisement opportunity trading method, and the computer readable medium, according to claims 1, 12, 23, and 34 respectively, wherein the advertisement data registration unit stores an advertisement data ID as part of the advertisement data in a market-use advertisement data storage unit via an advertisement data mirroring unit, wherein the advertisement data registration unit attaches an advertisement data name and the genre data representing a genre of the advertisement data which are inputted from an input unit of the sponsor-side terminal to the advertisement data stored in the market-use advertisement data storage unit, and wherein the advertisement data registration unit registers the advertisement data name and the genre data as part of the advertisement data. (Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 19, line 27 through Page 20, line 26; and Page 23, line 8 through Page 24, line 1) (Note that the cited sections indicate that advertisements are place in a database (registered) and must include an advertisement data identification number as per Page 23, line 8 through Page 24, line 1, where the stored advertisement is identified by its ad index in the database.)

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 9, 19, 20, 30, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. (WO 98/34189).

Claims 8, 9, 19, 20, 30, 31, and 36: Roth discloses the advertisement opportunity trading system according to claims 1, 12, 23, and 34 respectively. In the teachings of Roth, an advertiser creates form objects when bids are proposed. The fields in these form objects contain limitations and restrictions the advertiser specifies regarding ad placement (Page 27, line 4 through Page 28, line 6). While Roth does not explicitly disclose that these form objects are used to perform a competition check, so that advertisements from the same business category are not displayed simultaneously, Official Notice is taken that it is old and well known that advertisers place restrictions upon media outlets regarding the placement of competitive advertisements. If Ford were to purchase advertising space on a web page, they would not want an adjacent advertisement from a competitor such as General Motors to be displayed on the web page at the same time. Displaying competitive advertisements in this manner erodes the effectiveness of both companies advertising campaigns. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate criteria allowing such restrictions. One would have been motivated to accommodate advertiser restrictions in order to generate wide scale acceptance and use of the

automated bidding system and to help advertiser's maximize the effectiveness of their advertising budgets.

### ***Response to Arguments***

7. Applicant's arguments filed September 16, 2008 and December 22, 2008 have been fully considered but they are not persuasive.

a. The applicant argues that the claims of the current invention require that application for distribution for an advertisement opportunity are accepted before the advertisement is put up for auction and asserts that this order of operation does not occur in the teachings of Roth. The applicant relies on the statement of the current claims that recites "wherein in a case where said distribution accepting unit accepts applications for distribution of advertisement data from a plurality of sponsors for a same advertisement opportunity, said trade process unit puts up the advertisement opportunity for auction. The examiner disagrees that the limitations imposed by such a statement requires such an order of operation. The Examiner has determined that the "wherein" clause is considered an optional feature in the claim and is given little or no weight as per MPEP 2111.04. The claims are directed towards communication between **one of a plurality of sponsors** and **a terminal** of media which distributes an advertisement via a communication network, in order to intermediate between the one of a plurality of sponsors and the media for facilitating a trade for an advertisement. Thus, the claim does not require that there be more than one

sponsor communicating. Instead, while a plurality of sponsors are involved in the system only a single sponsor is claimed as communicating with the media.

However, in order to further the prosecution of the case the examiner points out that Roth discloses sending advertisements that a sponsor would like to display when an opportunity arises to a central server (advertisement data reception unit) (Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; and Page 35, lines 13-25). Note that the submission of advertisements to the advertising database (which is considered the advertisement data registration unit) can occur before an advertisement opportunity presents itself. Roth further discloses receiving an advertisement opportunity (advertisement opportunity reception unit) which contains various criteria regarding the type of advertisements that may be provided (advertisement opportunity registration data) and forwarding it from the view server (Page 8, lines 1-11; and Page 19, line 27 through Page 20, line 26). The advertisement data is checked regarding genre data (advertisement data check unit) (Page 8, lines 1-11; and Page 19, lines 27 through Page 20, line 26). Note that both the media presenting an opportunity and the bidder requesting an advertisement to be displayed can place limitations regarding the appropriateness of an advertisement for display (Page 20, line 16 discloses a genre limitation imposed by the site while Page 2, line 6 through Page 28, line 6 discloses such limitations imposed the advertiser). Roth further discloses that the view server send the view op to bidding agents who evaluate the given criteria for the advertiser and the view op to determine if a match can be made

(Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 12, line 19 through Page 13, line 2; Page 13, lines 13-23; and Page 22, lines 1-9). If a match can be made, then distribution is accepted and the trade process begins and bids are submitted back to the view server (Trade Process Unit) (Page 6, line 17 through Page 7, line 15; Page 8, lines 1-11; Page 12, line 19 through Page 13, line 2; Page 13, lines 13-23; and Page 22, lines 1-9). Finally, bids are accepted from various bidding agents and an auction process occurs wherein a determination is made regarding the winning bid. (Page 23, line 8 through Page 24, line 1). Thus, Roth does teach the specified order set forth in the clients arguments. The above explanation also points out where, in Roth, the advertisement data that is to be distributed is registered, as requested by the applicant.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/  
Examiner, Art Unit 3622